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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being e-filed with the USPTO on <u>June 11, 2008</u> Signature <u>/Dana Chan/</u> Typed or printed name <u>Dana Chan</u>		Application Number	Filed
		09/932,364	08/17/2001
		First Named Inventor	
		Michael P. Cockrill	
		Art Unit	Examiner
		3693	Weis, Samuel
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the		/KEVINZILKA/	
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Kevin J. Zilka	
<input checked="" type="checkbox"/> attorney or agent of record. 41,429		408-971-2573	
Registration number _____		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		June 11, 2008	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 51, 53, 55, 58, 60, 61, and 64 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner has argued that “[t]he language ‘on behalf of’ is vague and indefinite.” Applicant respectfully asserts that the claimed “on behalf of” in all of the pertinent claims is to be read with regards to its plain and ordinary meaning, as evidenced by dictionary definitions, etc. For example, one dictionary definition of “on behalf of” is “[a]s the agent of; on the part of” (*The American Heritage® Dictionary of the English Language, Fourth Edition*).

The Examiner has rejected Claims 51-53, 55, 56, 58-62, and 64 under 35 U.S.C. 103(a) as being unpatentable over Teper et al. (U.S. Patent No. 5,815,665), in view of Goldman et al. (U.S. Patent No. 5,684,951). Applicant respectfully disagrees with such rejection.

With respect to the independent claims, the Examiner has relied on the Abstract from Teper, and particularly Teper’s disclosure of an online brokering service, to make a prior art showing of applicant’s claimed technique “wherein the method is practiced on behalf of a first online service” (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the Abstract from Teper merely discloses an “Online Brokering Service [that] provides user authentication and billing services,” where “[u]sers...initially register with the Brokering Service.” However, Teper further teaches that “when a user connects to a registered SP [(Service Provider)] site and attempts to access an online service, the SP site initiates a challenge-response authentication sequence which allows the Online Brokering Service to authenticate the user for the SP site” (Col. 3, lines 5-9-emphasis added). Specifically, “the SP site sends a challenge message to the user’s computer over the distributed network (e.g., the Internet), and the user computer responds by generating and returning a cryptographic response message” (Col. 3, lines 9-13). In addition, “[t]he SP site forwards the response message to the Online Broker site along with the user’s unique ID (which the SP site obtains from the user computer) and the original challenge message,” in order for the “Online Brokering Service...to determine whether the response message was properly generated, and to thereby authenticate the user” (Col. 3, line 19-25-emphasis added).

Thus, Teper expressly discloses that a user registers with a brokering service, but that when a user connects to a service provider site, the service provider site sends the challenge message, receives the response message, and forwards such response message to the separate online broker site (see Figure 1). Clearly, Teper discloses two different sites, an online broker site that registers a user, and a service provider site that receives a response message from the user when the user connects to the service provider site and forwards such message to the online broker site for authenticating the user. Applicant emphasizes that use of the service provider site and the online broker site, as in Teper, fails to meet applicant's specifically claimed "method [that] is practiced on behalf of a first online service," where the method comprises both "registering a user" and "identifying the user by: (1) soliciting from the user the member identifier of the user; (2) [and] receiving the member identifier of the user" (see the same or similar, but not necessarily identical language in the independent claims-emphasis added - emphasis added), in the context claimed by applicant.

Additionally, applicant's arguments made on page 7, third paragraph, through page 8, second paragraph of Amendment C filed 12/13/2007 are hereby incorporated by reference.

In the Office Action mailed 03/11/2008, the Examiner failed to respond to applicant's above arguments with respect to applicant's claimed technique "wherein the method is practiced on behalf of a first online service." Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

In addition, with respect to the independent claims, the Examiner has relied on the Abstract of Teper, and in particular the online brokering service disclosed by Teper, to make a prior art showing of applicant's claimed technique "wherein a plurality of users having a same user computer system are registered by repeating (a)(1)-(a)(2) for each of the plurality of users" (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the Abstract from Teper, as relied on by the Examiner, merely discloses an "Online Brokering Service [that] provides user authentication and billing services to allow users to anonymously and securely purchase online services from Service Providers (SP) sites (e.g., World Wide Web sites) over a distributed public network." Clearly,

only generally disclosing allowing users to anonymously and securely purchase online services, as in Teper, fails to even suggest “a plurality of users having a same user computer system,” let alone that such a “plurality of users having a same user computer system are registered by repeating (a)(1)-(a)(2) for each of the plurality of users” (emphasis added), as specifically claimed.

In the Advisory Action mailed 11/20/2007, the Examiner has generally argued that “Teper discloses a method, system, and computer program for identifying a user using a user computer system among a group of users, comprising: registering and identifying the user.” The Examiner has also argued that “Teper further discloses multiple online services (Service Provider sites and online brokering service) where the user logs in using standard parameters (passwords, challenge questions, etc. called unique identifier by Applicant),” and that “Teper provides authentication for multiple users simultaneously.”

Applicant respectfully disagrees. First, applicant respectfully asserts that simply alleging that Teper discloses identifying a user that uses a user computer system among a group of users, as noted by the Examiner, fails to meet applicant’s claimed “plurality of users having a same user computer system [that] are registered by repeating (a)(1)-(a)(2) for each of the plurality of users” (emphasis added), as specifically claimed. Second, applicant points out that Figure 1 of Teper clearly shows a separate user computer system for each user, which does not suggest, and even seems to *teach away* from, applicant’s claimed “plurality of users having a same user computer system” (emphasis added), as specifically claimed.

In the Office Action mailed 03/11/2008, the Examiner failed to respond to applicant’s above arguments with respect to applicant’s claimed technique “wherein a plurality of users having a same user computer system are registered by repeating (a)(1)-(a)(2) for each of the plurality of users.” Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Also with respect to the independent claims, the Examiner has relied on Col. 6, lines 4-13 in Teper to make a prior art showing of applicant’s claimed technique “wherein the user is authenticated to the first online service utilizing the member identifier, the unique identifier, and a

password of the user” (see the same or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpt from Teper relied on by the Examiner only discloses that “[t]he user registers with the Online Broker by providing various user information (name, address, phone number, etc.) and payment information (credit card number, purchase order instructions, etc.) to the Broker,” and that “[t]he user additionally agrees to a contract, and establishes a personal password that is known only by the user and the Broker.” (Col. 6, lines 4-10). In addition, the excerpt teaches that “the Broker assigns a unique ID that can be mapped to the user only by the Broker, and provides the user with the client software components of the system” (Col. 6, lines 10-13). Therefore, applicant respectfully points out that such excerpt from Teper only relates to a user registering with the online broker, which simply does not even suggest that “the user is authenticated to the first online service” (emphasis added), as claimed.

In fact, applicant notes that Teper only discloses that “when a user initially connects to an SP site, the SP site transmits a challenge message over the public network to the user computer, and the user computer generates and returns [a] cryptographic response message (preferably generated using a password of the user)” (Abstract). In addition, Teper teaches that the “SP site then passes the response message to the Brokering Service, which in-turn looks up the user’s password and authenticates the response message,” such that “[i]f the response message is authentic, the Online Brokering Service transmits an anonymous ID to the SP site, which can be used for subsequently billing the user” (Abstract-emphasis added). Thus, Teper only discloses authenticating the response message, and does not teach that a “user is authenticated to the first online service utilizing the member identifier, the unique identifier, and a password of the user” (emphasis added), as specifically claimed.

In addition, applicant’s arguments made on page 10, third paragraph, through page 11, second paragraph of Amendment C filed 12/13/2007 are hereby incorporated by reference.

In the Office Action mailed 03/11/2008, the Examiner failed to respond to applicant’s above arguments with respect to applicant’s claimed technique “wherein the user is authenticated to the first online service utilizing the member identifier, the unique identifier, and a password of the user.” Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Further, with respect to the independent claims, the Examiner has relied on Figures 3-9 and Cols. 5-11 in Goldman to make a prior art showing of applicant's claimed technique "wherein the unique identifier includes an electronic mail address."

Applicant respectfully notes that the above excerpts relied on by the Examiner merely disclose that a "user validation system 310a of the present invention maintains a database having an entry for each authorized user," where "[e]ach entry includes the user's identification (user ID), the user's email address, and each IP address for which the user is authorized," and where "[t]he user's email address is known to the user validation system 310a upon user registration" (Col. 6, lines 12-19 – emphasis added). The excerpts further disclose that a "user terminal system 112 (FIG. 1) is used by the user to originate access requests to the application system 310 (which contains validation system 310a)" (Col. 5, lines 38-40 – emphasis added).

However, merely disclosing that a user validation system maintains a database of entries that include a user's email address, where the user's email address is known to the user validation system upon user registration, and where the user requests access to the application system which contains the user validation system, as in Goldman, does not teach that "the unique identifier includes an electronic mail address," where the "unique identifier for the user [is stored] on a user computer system in conjunction with the obtained member identifier" (see this or similar, but not necessarily identical language in the independent claims – emphasis added), in the context claimed by applicant.